



Q1 printing indicia on said label, said indicia identifying the compact disk [producing an adhesive label having dimensions of sufficient tolerances not to interfere with the operation of a compact disk drive mechanism, said label bearing printed indicia thereon identifying said compact disk]; and

applying said label to said compact disk.

Q2 Sub B21 8. (Amended) The method as set forth in claim 7 including a step of storing said list of data files in a computer database [providing means for] associating [a specific] data files from said list of data files with said printed indicia [corresponding to said compact disk].

Q3 Sub C11 11. (New Claim) The method as set forth in claim 6, wherein said adhesive label used in said applying step does not extend over a region of said compact disk bearing data tracks.

#### REMARKS

Claims 6-10 are pending in the application. Claims 6 and 8 have been amended. Claim 11 has been added.

Claim 6 has been amended to restate the claim in a clearer manner. Structural features of the claim have been moved into the preamble, whereas these features formerly existed in the body of the claim. The structural features differ in scope from the prior claim by now specifically stating that the dimensions of the adhesive label do not extend over the entire surface of the disk, as is shown by way of example in Fig. 2.

Claim 8 has been amended to recite that the computer database associates the data files on the disk with the indicia on the adhesive label. This capability is recited on page 14 of the specification at lines 18-22 and other places in the specification.

The Office Action dated May 9, 2000 includes a rejection of claim 6 over U.S. 4,879,710 to Iijima. The Iijima patent is nonanalogous art with respect to the present invention because it pertains to protective coverings for compact disks and is completely silent as to placing indicia on the protective covers in a manner that would convert them into labels. According to the standards in *Graham v. John Deere* 1489

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USPQ 459 (US 1966) relied upon by the examiner, the prior art must suggest a combination or modification to a reference. It is not enough for the examiner to allege that printing indicia on labels is well known and that indicia could have been printed on the protective cover shown in Iijima. There must also be the requisite suggestion that this type of printing should be done on the protective cover of Iijima, and this suggestion is lacking. Applicant's attorney disputes the contention that such printing is well known *as applied to compact disks*, as is presently claimed, and there is no reference of record showing this printing to be done or suggested. The respective disclosures of the present specification address completely different problems, namely those of protection versus labeling and, consequently, the idea of labeling the protective covers was not disclosed or suggested in Iijima. Furthermore, in considering the claimed invention as a whole, i.e., as an idea addressing the problem solved by the present applicants, it is clear that the present applicants have addressed and solved a completely different problem, again, that of protection versus labeling, than the problem that was addressed by Iijima.

The amended scope of claim 6, wherein the adhesive label does not extend over the entire surface of the disk would not have been contemplated by Iijima because this type of label would run contrary to the protective purpose of Iijima. Thus, Iijima teaches away from the amended scope of claim 6.

Claims 7-10 are rejected under 35 U.S.C. §103 as being unpatentable over Iijima, as discussed above, in combination with Ando et al. U.S. 5,521,900. Ando discloses writing information concerning the contents of a compact disk to a lead-in area on the disk. This writing is done digitally, and there is no teaching or suggestion of linking the digital information to an indicia-identifier on an adhesive label attached to the compact disk. It is also noted that the previous remarks concerning the inapplicability of the Iijima patent are equally applicable to the combination of Iijima and Ando et al.

Applicant's attorney respectfully solicits reconsideration and allowance of the application for the reasons stated above. No additional fees are believed to be due, but



the Commissioner is authorized to charge any additionally required fees to deposit account 501324.

Respectfully submitted,  
LATHROP, GAGE & SULLIVAN

By: \_\_\_\_\_

A handwritten signature in dark ink, appearing to be "Dan Cleveland, Jr.", followed by a checkmark.

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